

REMARKS**Amendments to the Claims**

Applicants presently amend claims 1, 12, 24, and 36 to include the following limitations, previously recited in dependent claims 11 and 23: caller identity comprises a caller name, a caller location, a subject of said call, and a device identification. Although Applicants have amended claims 1, 12, 24, and 36 to include additional limitations, Applicants do not concede that claims 1, 12, 24, and 36 as originally filed are not patentable over the art cited by the Office Action. In fact, Applicants reserve the right to pursue these originally filed claims in one or more continuation applications. Applicants submit that these amendments do not introduce any new matter, and submit that the claims as currently amended are in condition for allowance.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 1, 2, 4-9, 11-13, and 15-23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action at page 2 states:

Regarding claims 1 and 12, the phrase “said caller identity is transmittable” is indefinite because it is unclear whether said caller identity is transmitted to the destination or said caller identity is not transmitted to the destination.

Applicants understand this statement from the Office Action as an assertion that claims 1 and 12 that recites a ‘caller identity that is transmittable’ are indefinite because it is unclear to where the caller identity is transmitted. Applicants respectfully note in response, that 35 U.S.C. § 112, requires that the claims particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The subject matter recited in claims 1 and 12 are a method and system for identifying a particular caller. The method and system for identifying a caller identity includes the ability of a caller identity to be transmitted. However, claims 1 and 12 do not recite that

the caller identity *is* transmitted. That is, the *ability* to transmit the caller identity is the subject matter that is distinctly pointed out in the claim – not the *actual transmission* of the caller identity. Because Applicants' claims 1 and 12 particularly point out and recite a caller identity that is transmittable – not a caller identity that is transmitted, the rejections of claims 1 and 12 for failing to provide where a caller identity is transmitted, are improper and should be withdrawn. Applicants submit that Applicants' claims properly satisfy the definiteness requirement of 35 U.S.C. § 112, second paragraph, when analyzed in light of the factors from MPEP § 2173, and Applicants respectfully request reconsideration of the rejections.

Claim Rejections – 35 U.S.C. § 101

Claims 24-25 and 27-30 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action at page 3, states:

The Specification indicates that “computer readable media include recordable-type media, such as a floppy disk, a hard disk drive, a RAM, CD-ROMs, DVD-ROMs, and *transmission-type media, such as digital and analog communication links, wired or wireless communications links using transmission forms, such as, for example, radio frequency and light wave transmissions*”. Thus, reading independent claim 24 in light of the specification, the recited “computer readable medium” of these claims encompasses a carrier medium that conveys a signal.

Signals are not patentable under § 101.

In any event, *a carrier medium that conveys* a signal (e.g., a carrier wave) is distinguished from a tangible medium that *stores* a signal (e.g., a disk, memory, etc.), particularly with respect to the functionality of independent claim 24. This claim, in effect, call for means to interact with the computer to perform specific functions. It is our view that the computer cannot perform the claimed functions while the instructions are within signals conveyed by a carrier wave.

Specifically, information sent by the carrier wave conveying signals is transmitted by modulating the carrier wave or signal with the information. This information must be received and demodulated before the information is available for use. Thus, the information, *while on the carrier wave or signal*, is unavailable to the computer for performing the

functions recited in independent claim 24. It is also likely that all the information necessary to perform the functions of claim 24 never exists within the carrier wave or signal at any one time. In other words, it is typical for information that is transmitted by signals conveyed by carrier waves to begin to be received at the receiver before all the information is transmitted. Therefore, it appears that program instructions for carrying out the claimed invention cannot exist while the information is being transmitted via signals conveyed by a carrier wave.

Furthermore, while the exemplary “transmission-type media” disclosed on page 29 of the Specification certainly implicates physical carriers of information, the disclosure hardly limits the carriers to these examples. Rather, nothing in the passage precludes the use of any tangible means of information carriage.

Thus, when read in light of the Specification, independent claim 24 includes both statutory subject matter (signals stored on a tangible medium) and non-statutory subject matter (signals conveyed by a carrier medium). According to USPTO guidelines, however, such claims must be amended to recite solely statutory subject matter.

For the foregoing reasons, independent claim 24 or the claims dependent thereon do not recite statutory subject matter under 35 U.S.C. § 101.

Applicants understand this statement the from the Office Action as an assertion that Applicants’ usage of the term ‘recording medium’ in claims 24, 25, and 27-30 renders Applicants’ claims outside the realm of statutory subject matter because ‘recording medium’ encompasses ‘transmission medium.’ In asserting that Applicants’ claims are directed toward non-statutory subject matter because ‘recording medium’ encompasses ‘transmission medium,’ the Office Action implies that Applicants’ claims are directed toward non-statutory subject matter because a ‘transmission medium’ may be used to transfer signals. The current law regarding the patentability of signals is *In re Nuijten*, No. 06-1371 (Fed. Cir. 2007). In *Nuijten*, the Court held that a signal claimed as a signal is not statutory subject matter eligible for patentability. Applicants note in the present application, however, that Applicants are not claiming a signal as a signal—rather, Applicants are claiming a computer program product that includes a recording medium on which suitable programming means may be recorded. In fact, the Court in *Nuijten* noted that the Board of Patent Appeals and Interferences (‘BPAI’) decided that a similar claiming pattern in *Nuijten* was directed toward statutory subject matter stating:

Finally, Nuijten's allowed Claim 15 is directed to "[a] storage medium having stored thereon a signal with embedded supplemental data..."

...

On appeal, the Board reversed the double-patenting rejections. As to Claim 15, it found that "[t]he storage medium in claim 15 nominally puts the claim into the statutory category of a 'manufacture'" and thus reversed the Examiner's § 101 rejection of that claim.

For the same reasons that the BPAI held that the claims in *Nuijten* directed toward storage medium having stored thereon a signal with embedded supplemental data, Applicants submit that claims 24-25 and 27-30 directed toward a computer program product that includes a recording medium on which suitable programming means may be recorded is also patentable under 35 U.S.C. § 101.

Furthermore, Applicants note that even though the term 'recording medium' encompasses the term 'transmission medium,' Applicants' original specification describes a 'transmission medium' as being a suitable recording medium for machine-readable information, which is used to embody the computer program product claimed in the present application. Nothing in the cited reference or any other language in the specification or the claims describes 'transmission media' as a signal or under any reasonable interpretation implies that Applicants are claiming a signal. In addition, Applicants note that the Fifth Edition of the Microsoft Computer Dictionary defines the term 'media' as "a physical material, such as paper, disk, and tape, used for storing computer-based information." One of ordinary skill in the art would therefore understand that 'transmission media' is a physical material and entitled to patent protection under 35 U.S.C. § 101 as an article of manufacture or a composition of matter. The rejections of claims 24-25 and 27-30 under 35 U.S.C. § 101 are improper, and should therefore be withdrawn. Applicants respectfully request reconsideration of claim 24-25 and 27-30.

**Claim Rejections - 35 U.S.C. § 103 Over
Farris In View Of Velius And Manto**

Claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Farris (U.S. Patent 6,122,357) in view of Velius (U.S. Patent 5,594,784) in further view of Manto (U.S. Patent 6,285,749). The question of whether Applicants claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants claims for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of Farris and Velius must teach or suggest all of Applicants' claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). As shown below in more detail, the proposed combination of Farris, Velius, and Manto cannot establish a prima facie case of obviousness because the proposed combination of Farris, Velius, and Manto does not teach each and every element of the claims of the present application. The rejection of claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36 should therefore be withdrawn and the claims should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36.

**The Proposed Combination Of Farris, Velius, and Manto
Does Not Teach Or Suggest Each And Every Element
Of Claim 1 Of The Present Application**

To establish a prima facie case of obviousness under 35 U.S.C. § 103 the reference must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180

USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application, as amended in this Response, recites:

1. A method for identifying a particular caller, said method comprising:

detecting a voice utterance at an origin device, the origin device further comprising a telephony device utilized for origination of a call;

identifying a caller identity associated with said voice utterance at said origin device, such that said caller identity is transmittable as an authenticated identity of said caller for a call, wherein said caller identity comprises a caller name, caller location, a subject of said call, and a device identification; and

prompting said caller to enter an additional biometric input to verify said caller identity, wherein said biometric input comprises at least one from among an eye print, a finger print, and a body heat scan.

As explained in more detail below, the proposed combination of Farris, Velius, and Manto does not teach or suggest each and every element of claim 1 as amended in this Response. Applicants therefore respectfully traverse each rejection individually and request that the rejections be withdrawn.

The Proposed Combination Of Farris, Velius, and Manto Does Not Teach Or Suggest Caller Identity Comprises A Caller Name, Caller Location, A Subject Of Said Call, And A Device Identification

Claim 1 of the present application is amended to include the following limitation: caller identity comprises a caller name, caller location, a subject of said call, and a device identification. This limitation includes limitations previously recited in claim 11 of Applicants' original application. The Office Action takes the position that Farris at column 19, line 40 and column 35, lines 23-24 discloses each and every element and

limitation of claim 11. Applicants respectfully note in response, however, that what Farris at column 19, line 40 in fact discloses is:

The IP plays an audio prompt message asking the caller, 'Please say your full name'. The process may ask for any appropriate identifying information.

In addition, what Farris at column 35, lines 23-24, in fact discloses is:

IP is apprised of this requirement and uses another prompt to the calling party to identify herself. This may be a prompt such as "Who is calling?"

That is, Farris at column 19, line 40 and column 35, lines 23-24, disclose audio prompts that ask the caller to identify him or herself. Farris' audio prompts that ask the caller to identify him or herself do not disclose caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present application. Farris' prompts establish the caller's name – not the subject of said call or the device information. That is, Farris' speech authentication identification only identifies the name of the person calling. Without disclosing the subject of the call or the device information, Farris does not disclose caller identity, as claimed in the present application. In addition to Farris not disclosing caller identity, Velius and Manto also fail to disclose caller identity, as claimed in the present application. Velius discloses a telephony system with caller identification services that include displaying the caller's telephone number, and the reproduction of the caller's voice utterance. *See* Velius, column 2, lines 38 – 42. However, Velius is not concerned with and does not teach or suggest caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present application. Manto discloses verifying authorized users using security codes such as PIN numbers, digital signatures, smart cards, interactive video, or other security systems including pseudo-random number generators, finger print, bio-feedback, infrared scans of capillary heat generation and retina scans. *See* Manto, column 5, lines 1-19. However, Manto is not concerned with and does not teach or suggest caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present

application. Because neither Farris, Velius, or Manto, either alone or in combination, teaches or suggests each and every element and limitation of Applicants' claims, the proposed combination of Farris, Velius, and Manto cannot be used to establish a prima facie case of obviousness. Applicants' claims are therefore allowable and the rejections under 35 U.S.C. § 103 should be withdrawn.

Relations Among Claims

Independent claims 12 and 24 are system and computer program product claims for data customization for data of disparate data types that correspond to independent method claim 1. Claim 1 is allowable for the reasons set forth above. Claims 12 and 24 are allowable because claim 1 is allowable. The rejections of claims 12 and 24 therefore should be withdrawn, and claims 12 and 24 should be allowed. Applicants respectfully request reconsideration of claims 1, 12, and 24.

Claims 2-9, 13, 15-22, 25, 27-30 depend from independent claims 1, 8, and 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. For the same reason that Farris, Velius, and Manto does not teach and suggest each and every element of independent claims 1, 12, and 24, so also Farris, Velius, and Manto cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 2, 4-7, 13, 15-18, 21, 23, 25, 27-30 should be withdrawn, and these claims also should be allowed. Applicants respectfully request reconsideration of claims 2, 4-7, 13, 15-18, 21, 23, 25, 27-30.

The Proposed Combination Of Farris, Velius, and Manto Does Not Teach Or Suggest Each And Every Element Of Claim 36 Of The Present Application

To establish a prima facie case of obviousness under 35 U.S.C. § 103 the reference must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 36 of the present application, as amended in this Response, recites:

36. A method for caller identification, comprising:

detecting a call request at an origin device, the origin telephony device further comprising a telephony device utilized for origination of a call;

detecting a voice utterance at said origin device from a caller;

accessing a third party system for a voice imprint corresponding to said voice utterance;

authenticating, at the origin device, an identity of said caller identified in said voice imprint by matching said accessed voice imprint with said voice utterance; and

prompting said caller to enter an additional biometric input to verify said caller identity, wherein said biometric input comprises at least one from among an eye print, a finger print, and a body heat scan, wherein said caller identity comprises a caller name, a caller location, a subject of said call, and a device identification.

As explained in more detail below, the proposed combination of Farris, Velius, and Manto does not teach or suggest each and every element of claim 36 as amended in this Response. Applicants therefore respectfully traverse each rejection individually and request that the rejections be withdrawn.

The Proposed Combination Of Farris, Velius, and Manto Does Not Teach Or Suggest Caller Identity Comprises A Caller Name, Caller Location, A Subject Of Said Call, And A Device Identification

Claim 36 of the present application is amended to include the following limitation: caller identity comprises a caller name, caller location, a subject of said call, and a device

identification. This limitation includes limitations previously recited in claim 11 of Applicants' original application. The Office Action takes the position that Farris at column 19, line 40 and column 35, lines 23-24 discloses each and every element and limitation of claim 11. Applicants respectfully note in response, however, that what Farris at column 19, line 40 in fact discloses is:

The IP plays an audio prompt message asking the caller, 'Please say your full name'. The process may ask for any appropriate identifying information.

In addition, what Farris at column 35, lines 23-24, in fact discloses is:

IP is apprised of this requirement and uses another prompt to the calling party to identify herself. This may be a prompt such as "Who is calling?"

That is, Farris at column 19, line 40 and column 35, lines 23-24, disclose audio prompts that ask the caller to identify him or herself. Farris' audio prompts that ask the caller to identify him or herself do not disclose caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present application. Farris' prompts establish the caller's name – not the subject of said call or the device information. That is, Farris' speech authentication identification only identifies the name of the person calling. Without disclosing the subject of the call or the device information, Farris does not disclose caller identity, as claimed in the present application. In addition to Farris not disclosing caller identity, Velius and Manto also fail to disclose caller identity, as claimed in the present application. Velius discloses a telephony system with caller identification services that include displaying the caller's telephone number, and the reproduction of the caller's voice utterance. *See* Velius, column 2, lines 38 – 42. However, Velius is not concerned with and does not teach or suggest caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present application. Manto discloses verifying authorized users using security codes such as PIN numbers, digital signatures, smart cards, interactive video, or other security systems including pseudo-random number generators, finger print, bio-feedback, infrared scans of capillary heat generation

and retina scans. *See* Manto, column 5, lines 1-19. However, Manto is not concerned with and does not teach or suggest caller identity that comprises a caller name, caller location, a subject of said call, and a device identification, as claimed in the present application. Because neither Farris, Velius, or Manto, either alone or in combination, teaches or suggests each and every element and limitation of Applicants' claims, the proposed combination of Farris, Velius, and Manto cannot be used to establish a prima facie case of obviousness. Applicants' claims are therefore allowable and the rejections under 35 U.S.C. § 103 should be withdrawn.

**Claim Rejections – 35 U.S.C. § 103 Over Farris
In View Of Velius, Manto, And Chan**

Claims 8, 9, and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Farris in view of Velius, Manto, and Chan (U.S. Patent 6,925,166). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). The Office Action relies on the previous 35 U.S.C. § 103 rejection above to reject dependent claims 8, 9, and 22. Regarding the previous 35 U.S.C. § 103 rejection above, Applicants have demonstrated that the combination of Farris, Velius, and Manto does not teach or suggest each and every element of independent claims 1, 12, and 24. Dependent claims 8, 9, and 22 depend from independent claims 1, 12, and 24, and include all of the limitations of the claims from which they depend. Because the proposed combination of Farris, Velius, Manto, and Chan relies on the argument that the proposed combination of Farris, Velius, and Manto teaches or suggests each and every element of claims 1, 12, and 24, and because the proposed combination of Farris, Velius, and Manto does not teach or suggest each and every element of claim 1, the proposed combination of Farris, Velius, Manto, and Chan cannot teach or suggest all the claim limitations of claims 8, 9, and 22. The proposed combination of Farris, Velius, Manto, and Chan therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

**Claim Rejections – 35 U.S.C. § 103 Over Farris
In View Of Velius, Manto, And Baker**

Claims 9 and 20 stand rejected under 35 U.S.C § 103(a) as unpatentable over Farris in view of Velius, Manto, and Baker (U.S. Patent 6,925,166). To establish a prima facie case of obviousness, the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *Manual of Patent Examining Procedure* § 2142 (citing *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974)). The Office Action relies on the previous 35 U.S.C. § 103 rejection above to reject dependent claims 9 and 20. Regarding the previous 35 U.S.C. § 103 rejection above, Applicants have demonstrated that the combination of Farris, Velius, and Manto does not teach or suggest each and every element of independent claims 1, 12, and 24. Dependent claims 9 and 20 depend from independent claims 1, 12, and 24, and include all of the limitations of the claims from which they depend. Because the proposed combination of Farris, Velius, Manto, and Baker relies on the argument that the proposed combination of Farris, Velius, and Manto teaches or suggests each and every element of claims 1, 12, and 24, and because the proposed combination of Farris, Velius, and Manto does not teach or suggest each and every element of claim 1, the proposed combination of Farris, Velius, Manto, and Baker cannot teach or suggest all the claim limitations of claims 9 and 20. The proposed combination of Farris, Velius, Manto, and Baker therefore, cannot establish a prima facie case of obviousness, and the rejections should be withdrawn.

Conclusion

Claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over the combination of Farris, Velius, and Manto. For the reasons set forth above, however, the proposed combination of Farris, Velius, and Manto cannot be used to establish a prima facie case of obviousness against claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36 of the present application. The rejection of claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36 under 35 U.S.C. § 103 should therefore be withdrawn and the claim should be allowed. Applicants

respectfully request reconsideration of claims 1-2, 4-7, 11-13, 15-18, 21, 23-25, 27-30, and 36.

Claims 8, 9, and 22 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over the combination of Farris, Velius, Manto, and Chan. For the reasons set forth above, however, the proposed combination of Farris, Velius, Manto, and Chan cannot be used to establish a prima facie case of obviousness against claims 8, 9, and 22 of the present application. The rejection of claims 8, 9, and 22 under 35 U.S.C. § 103 should therefore be withdrawn and the claim should be allowed. Applicants respectfully request reconsideration of claims 8, 9, and 22.

Claims 9 and 20 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over the combination of Farris, Velius, Manto, and Baker. For the reasons set forth above, however, the proposed combination of Farris, Velius, Manto, and Baker cannot be used to establish a prima facie case of obviousness against claims 9 and 20 of the present application. The rejection of claims 9 and 20 under 35 U.S.C. § 103 should therefore be withdrawn and the claim should be allowed. Applicants respectfully request reconsideration of claims 9 and 20.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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By:

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